

## **REMARKS AND DISCUSSION:**

Upon entry of the present Amendment-E, the claims pending in the present application are claims 1, 5-14, 16, and 20-21, of which claims 1 and 20 are independent. Claims 1, 20 and 21 have been amended by the present Amendment-E. Claims 3 and 15 have been canceled by the present Amendment-E without prejudice and without abandonment or dedication of the subject matter thereof.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment-E is submitted.

It is contended that by the present Amendment-E, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

## **Amendments Presented**

*In the Claims:* Claim 1 has been amended herein to include the subject matter of claims 3 and 15 (now canceled).

Claim 20 has been amended to specify that the IC tags and the database are configured to be updated as needed.

Claim 21 has been amended for consistency with claim 20.

Applicant respectfully submits that the above amendments to the claims are fully supported by the original disclosure including drawings. Applicant also respectfully submits that no new matter is introduced into the application by amending the claims, since the entire subject matter thereof was expressly or inherently disclosed in the original claims, specification and the drawings.

### **Claim Rejection --- 35 USC §112**

In the Office Action (page 2, item 2), the Examiner rejected claim 20 under 35 USC §112, first paragraph, as failing to comply with the written description requirement. The Examiner has taken the position that, in her view, the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that that inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner states that the claimed limitation, “the IC tag and the database are updated continuously” is not disclosed in the specification, and therefore (in the view of the Examiner) constitutes impermissible new matter.

#### ***Applicant's Response:***

As stated above, applicant has amended claim 20, herein. Upon careful consideration of the Examiner's rejection and in light of the above amendment to claim 20, applicant respectfully traverses such rejection and respectfully submits that the rejection is overcome.

Specifically, applicant submits that paragraph [0096] of the specification of the present application appears to generally convey and describe the limitation, “the IC tag and the database are updated continuously”. For example, paragraph [0096] discloses;

Data (owner data, component parts data, vehicle history data, and waste management tag issuance data) stored in the vehicle information database 202 and data (owner data, component parts data, vehicle history data, and waste management tag issuance data) stored in the IC tag are suitably updated in synchronization with each other as necessary.

Notwithstanding the above, in an effort to expedite the prosecution of the present application and possibly place claim 20 in condition for allowance, applicant has amended claim 20. Specifically, applicant submits that claim 20 has been amended to specify that the IC tags and the database are configured to be updated as needed.

Therefore, applicant respectfully requests reconsideration and withdrawal of the rejection of record under 35 USC 112.

### **Claim Rejection – 35 USC 103**

1. In the Office Action (page 2, item 4), the Examiner rejected claims 1, 3 and 5-16 under 35 USC 103(a) as being unpatentable over Tamai in view of Vock et al. or Didomenico et al. and further in view of Shimura or Lauffenburger. The Examiner is taking the position that, in her view, the location of such RFID tag is an obvious matter of design choice.
2. In the Office Action (page 5, item 6), the Examiner rejected claims 20 and 21 under 35 USC 103(a) as being unpatentable over Tamai in view of Vock and further in view of Michael et al. and Berquist et al. The Examiner is taking the position that, in her view, the location of such RFID tag is an obvious matter of design choice.

### ***Applicant's Response:***

As stated above applicant has amended claims 1 and 20, herein. Upon careful consideration and in light of the above amendments, applicant respectfully traverses the Examiner's rejection and submits that all of the pending claims are patentably distinguished over the applied references, because the references do not teach or suggest the features claimed in the present application. Further, applicant respectfully disagrees with the Examiner's position relative to design choice and submits that the location of the RFID tag is not an obvious matter of design choice if it can be shown how such location of the tag is effective in establishing and effectuating the objective(s) of the invention.

Applicant respectfully submits that the location of the IC tag in a resin member is advantageous and aids in the achieving the objective of the present invention and is not a matter of obvious design choice. The objectives of the present invention are to provide an IC tag equipped vehicle that provides a resin member that houses an IC tag therefore eliminating the requirement of incorporating an additional/separate housing to encapsulate the IC tag in order to provide a high sealing ability and to provide a vehicle equipped with an IC tag which can withstand use in a severe environment. These objectives and advantageous characteristics of the present invention are not disclosed nor contemplated by the references of record.

According to the features of the claimed invention, because an IC tag is housed in a case formed of a material having transmissivity to electromagnetic waves, the IC tag can be protected from wind, rain and dust without interrupting its transmitted/received electromagnetic waves and because the IC tag can be housed in a meter unit having a high sealing ability, another case having a high sealing ability will not be required, thus lowering production costs.

However, in an effort to expedite the prosecution of the present application and possibly place the entire application in condition for allowance, applicant has amended claim 1, herein. For example, claim 1 has been amended to include the subject matter of claims 3 and 15 (now canceled). Applicant submits that such amendments to claim 1 further define and patentably distinguish the present invention over the references of record and better describes the features of the claimed invention that aid in achieving the overall objectives present invention.

For example, applicant submits that according to the invention of amended claim 1, the IC tag is installed on a back surface of the meter panel (comparatively on a high position in a motorcycle), electromagnetic waves can reliably reach the IC tag during writing and reading operations. In addition, it is not necessary to provide a specific casing for the IC tag because the IC

tag is installed on (or in) the meter panel within the meter unit.

Furthermore, because the IC tag is installed on a *back surface* of the meter panel, deterioration of the IC tag due to sun light, ultraviolet rays, and heat of the sun can be prevented. In contrast, Vock et al. teaches the IC tag is installed on a flexible strip, deterioration of the IC tag due to bending, ultraviolet rays, or heat of the sun may easily occur.

Moreover, such feature more narrowly serves a present objective of the present invention to provide a vehicle equipped with an IC tag which can withstand use in a severe environment. Also, we note that by incorporating the IC tag within the resin meter panel (rather than within a metal structure) due to the resin material having transmissivity to electromagnetic waves, the sensitivity of wireless communication between the IC tag and reader is not unduly lowered.

Regarding Didomenico, although the Examiner is correct in stating that Didomenico teaches that the transponder may be located within a tag that is placed within the vehicle (e.g. hung from a rear view mirror, placed on the dashboard, etc.), or that is integral within the vehicle (e.g. part of a global positioning system), or located within the engine of the vehicle or elsewhere (col. 9, lines 11-16), applicant submits that Didomenico fails to teach (or even suggest) does not place an IC tag on a back surface of the meter unit.

Additionally, applicant submits that the deficiencies of Didomenico is not overcome by any additional teaching contained within Lauffenburger, which also fails to expressly teach such limitation.

Relative to the Examiner's rejection of claim 20, upon careful consideration of the Examiner's rejection and the applied references, applicant respectfully traverses such rejection and submits that the rejection is overcome because the references, whether considered singly or in combination thereof, still fail to teach (or even suggest) all of the features of claim 20 for the several

reasons discussed at pages 13-14 of Amendment-D filed on March 25, 2009.

Applicant re-asserts that the combination of the references fails to disclose a terminal device a database connected to the host server and managing tag information on an IC tag of each motorcycle by a motorcycle ID, a terminal comprising a device for wirelessly communicating with and reading the motorcycle ID from an IC tag provided on the motorcycle, a device for transmitting the motorcycle ID and an authorized access ID, to the host server, a device for receiving tag information transmitted from the host server in response to the motorcycle ID, and a host server comprising a device for searching the database by the motorcycle ID received from the terminal as a search key to selectively extract tag information corresponding to the motorcycle ID, as allowed by the authorized access ID.

Moreover, applicant submits that the deficiencies of Tamai and Vock (relative to claim 20) are not overcome by any additional teaching contained within Michael et al. or Berquist et al.

### **The Standard for Obviousness**

The U.S. Supreme Court has recently held, “[A] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. . . . Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known. *KSR v. Teleflex*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (S.Ct.2007).

In this regard, the Examiner must provide a valid reason why he or she feels that it would be obvious to combine the elements of the cited references in the fashion claimed by applicant. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in

*KSR v. Teleflex, supra.*)

The U.S. Supreme Court has also stated that a factfinder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See *Graham*, 383 U. S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight”). *KSR v. Teleflex, supra.*

Applicant respectfully submits that the Examiner has not provided a convincing or persuasive reason why it would be appropriate to combine the references in the manner suggested by the Examiner, and respectfully points out that even if the references are hypothetically combined, for the sake of argument, the combination fails to produce applicant’s invention as claimed.

Applicant respectfully submits that the differences between the claimed invention and the cited references are substantial and significant, and therefore, applicant’s invention is non-obvious as compared to the respective teachings of the references.

For all of the foregoing reasons, applicant respectfully requests reconsideration and withdrawal of the rejection of 1, 3, 5-16, 20 and 21 under 35 USC §103 as unpatentable in view of the prior art to Tamai, Vock et al., Didomenico et al., Shimura, Lauffenburger, Michael et al. and Berquist et al.

#### **Other Matters**

The additional reference cited by the Examiner included with the Office Action – US Patent 7,152,779 to Yamagiwa and 7,503,506 to Harada et al. have been considered by applicant, but this additional reference fails to overcome the deficiencies of Tamai, Vock et al., Didomenico et al., Simura, Lauffenburger, Michael et al. and Berquist et al. for the same reasons discussed above.

### Conclusion

Based on all of the foregoing, applicant respectfully submits that all of the objections and rejections set forth in the Office Action are overcome, and that as presently amended, all of the pending claims are believed to be allowable over all of the references of record, whether considered singly or in combination. Applicant requests reconsideration and withdrawal of the rejection of record, and allowance of the pending claims.

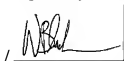
The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner is not fully convinced of the allowability of all of claims now in the application, or feels that the prosecution of the application could be advanced by a telephone discussion, applicant respectfully requests that he telephonically contact applicant's undersigned representative to expeditiously resolve any issues remaining in the prosecution of the application.

Favorable reconsideration is respectfully requested.

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### CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted, via EFS-Web, to the United States Patent and Trademark Office, on 21 July, 2009.



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WDB/rg